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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/769,392

Filing Date: January 26, 2001

Appellant(s): ORII ET AL.

Ellen R. Smith
(Registration No. 43,042)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on December 12, 2007 appealing from the

Office Action (Final Rejection) mailed on July 03, 2006.

REAL PARTY IN INTEREST

1. The statement identifying the real party in interest is contained in the appeal brief (NEC BIGLOBE, LTD. By virtue of an assignment executed by NEC Corporation).

RELATED APPEALS AND INTERFERENCES

2. The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

3. The statement of the status of claims contained in the appeal brief is correct.

Claims 3, 5-6, 9, 11-12, 15, 17-19, and 25 are pending and involving in this appeal.

Claims 1-2, 4, 7-8, 10, 13-14, 16, and 20-24 have been canceled.

STATUS OF AMENDMENT

4. The statement of the status of amendment after final rejection contained in the appeal brief is correct.

SUMMARY OF CLAIMED SUBJECT MATTER

5. The summary of claimed subject matter contained in the appeal brief is correct.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

6. The statement of the grounds of rejection to be reviewed on appeal is correct.

CLAIMS APPENDIX

7. The copy of the appealed claims contained in the Appendix to the appeal brief is correct.

EVIDENCE RELIED UPON

8. List of evidence relied upon.
 - (a) US Patent No. 6,813,608, published on November 02, 2004, filed on March 14, 2000 by Baranowski.

GROUND OF REJECTION

9. Claims 3, 5-6, 9, 11-12, 15, 17-19, 22, and 25 have been rejected under 35 U.S.C. 102(e) as being anticipated by Baranowski, U.S. Patent No. 6,813,608. Claim 19 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Baranowski, U.S. Patent No. 6,813,608 in view of "Official Notice."

CLAIM REJECTIONS - 35 USC § 102(e)

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 3, 5-6, 9, 11-12, 15, 17-18, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Baranowski (U.S. Patent No. 6,813,608).

Baranowski's patent meets all the limitations for claims 3, 5-6, 9, 11-12, 15, 17-18, and 25 recited in the claimed invention.

12. As to claim 3, Baranowski teaches a system for distributing information on a shopping mall to portable terminals of customers (figure 1; and column 4 lines 28-67), comprising:

a terminal (controller/point-of-sale equipment) located in a store in the shopping mall operative to register in advance first information (advertising of products, services, sales, and offers see column 8 lines 15-35) on the shopping mall, second information (schedule, weather forecasts, industry news, and any other information that may be useful to the customers see column 15 lines 1-30) on the shopping mall, distributing time of the first information and attribute information (information about items for sale, purchase total, and approval of credit for purchases see column 8 lines 15-26) regarding each store in the shopping mall requesting its distribution (figures 1-3; column 7 line 65 to column 8 line 46; and column 8 line 64 to column 9 line 58);

a means for registering in advance preference information regarding each customer (column 8 lines 22-26; and column 13 line 62 to column 14 line 28);
a means for perceiving (base station/portable device) a visit of the shopping mall by a customer (figure 1; column 2 lines 17-47; and column 4 line 56 to column 5 line 60);

a means for distributing, when the specific area by distributing time comes, only the items regarding which the attribute information of the store requesting the distribution matches the preference information of the customer, out of the first information, to a portable terminal of the customer perceived to be visiting the shopping mall (figure 1; column 7 line 65 to column 8 line 46; column 8 line 64 to column 9 line 58; and column 12 lines 30-42) and for distributing the second information, differing from the first information, to portable terminals of customers not perceived to be visiting the shopping mall (figure 5; column 13 line 53 to column 14 line 36; and column 15 lines 1-30).

13. As to claim 5, Baranowski teaches that the first information concerns a special sale, and customers are enabled to make an advance booking with a store by responding through the portable terminals (see abstract; figure 1; column 4 lines 56-67; column 8 lines 27-63; and column 14 lines 17-36).

14. As to claim 6, Baranowski teaches that the first information concerns a degree of congestion at an attraction or a restaurant, and customers are enabled to make an advance booking with the attraction or restaurant by responding through the portable terminals (figure 5; column 12 line 64 to column 13 line 52; and column 15 lines 1-64).

15. Claims 9, 11-12, 15, and 17-18 represent method and program that are parallel to the system of claims 3 and 5-6. Claims 9, 11-12, 15, and 17-18 do not teach or define any new limitations above claims 3 and 5-6; therefore, they are rejected for similar reasons.

16. Claim 25 does not teach or define any new limitations above claim 3; therefore, it is rejected for similar reasons. Additionally, Baranowski discloses a server having a processor and teaches that the processor performs the steps of: registering, perceiving, and distributing (figures 1-3; and columns 4-7)

CLAIM REJECTIONS - 35 USC § 103(a)

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baranowski (U.S. Patent No. 6,813,608) in view of “Official Notice.”

19. As to claim 19, Baranowski fails to teach the claimed limitation wherein the plurality of grouped storage media is divided into a plurality of segments, and each divided segment is recorded on one or another of the plurality of storage media. Baranowski discloses that each (base station, system controller, and portable device) having storage media (memory) for storing executable programs, which are enabling a computer system to distribute information on a shopping mall to portable device of customers (figures 1-3; column 5 lines 61-67; column 6 lines 15-25; and column 7 lines 5-13). “Official Notice” is taken that the concept and advantages of dividing the program into a plurality of segments, and each divided segment is recorded on one or another of said plurality of storage media is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Baranowski by dividing the program into a plurality of segments, and each divided segment is recorded on one or another of the plurality of storage media because it would have improved memory organization and memory access control.

RESPONSE TO ARGUMENTS

20. Applicant's arguments with respect to claims 3, 5-6, 9, 11-12, 15, 17-19, and 25 filed on December 12, 2007 have been fully considered but they are not deemed to be persuasive.

21. As per appellants' arguments filed on December 12, 2007, appellants argued in substance that: rejection under 35 USC § 102(e) and 103(a). The examiner summarizes the various points raised by the appellant and addresses them individually.

(A) Argument: The claimed second information is 1) registered by the terminal in a shopping mall and 2) distributed to portable terminals of customers, not perceived to be visiting said shopping mall. Appellant submits that Baranowski fails to disclose the second information.

Response: Baranowski clearly discloses two different information 1) first information (advertising of products, services, sales, and offers) storing/registering on a shopping mall (figure 1; and column 8 lines 15-35) and 2) second information (information about items for sale, purchase total, and approval of credit for purchases) storing/registering on the shopping mall (figure 5; and column 15 lines 1-30); and also clearly teaches that distributing the second information, differing from the first information, to portable terminals of customers not perceived to be visiting the shopping mall (figure 5; column 13 line 53 to column 14 line 36; and column 15 lines 1-30).

Accordingly, appellant's arguments that "Baranowski fails to disclose the second information" are moot.

(B) Argument: The web host, however, distributes the information irrespective of where the customer is. The information is only distributed based on the customer's selection of the merchandise or order placement; the system does not pay any attention to the customer's location before sending the information.

Response: Baranowski clearly teaches a system, which is automatically figure it out that when customer access system controller via web host using Internet, distribute extra-specific area information useful for customers outside the facility (figure 5; column 13 line 53 to column 14 line 36; and column 15 lines 1-30) and when customer access system controller via base station using wireless network, distribute intra-specific area information useful for customers within the facility (figure 1; column 7 line 65 to column 8 line 46; column 8 line 64 to column 9 line 58; and column 12 lines 30-42). The system distribute the information is not only based on the customer's selection of the merchandise or order placement (see column 8 lines 28-34; and column 15 lines 20-30). Accordingly, appellant's arguments that "the system does not pay any attention to the customer's location before sending the information" are moot.

(C) Argument: The web host of Baranowski distributes the information irrespective of where the customer is. The information is distributed based only on the customer's reservation and the web host does not pay any attention to the customer's current location at the time of distributing the information.

Response: Baranowski clearly teaches a system, which is automatically figure it out that when customer access system controller via web host using Internet, distribute extra-specific area information useful for customers outside the facility (figure 5; column 13 line 53 to column 14 line 36; and column 15 lines 1-30) and when customer access system controller via base station using wireless network, distribute intra-specific area information useful for customers within the facility (figure 1; column 7 line 65 to column 8 line 46; column 8 line 64 to column 9 line 58; and column 12 lines 30-42). Accordingly, appellant's arguments that "Baranowski distributes the information irrespective of where the customer is" are moot.

(D) Argument: Appellant respectfully requests the Examiner to clarify to point out the alleged "second information" in a more precise manner if the rejection of claim 3 was to be maintained.

Response: Examiner rewrote the rejection of claim 3 to clarify the alleged "second information" in a more precise manner (see modified rejection of claim 3 in section 12). Baranowski clearly discloses two different information 1) first information (advertising of products, services, sales, and offers) storing/registering on a shopping mall (figure 1; and column 8 lines 15-35) and 2) second information (information about items for sale, purchase total, and approval of credit for purchases) storing/registering on the shopping mall (figure 5; and column 15 lines 1-30); and also clearly teaches that distributing the second information, differing from the first information, to portable terminals of customers not perceived to be visiting the shopping mall (figure 5; column 13 line 53 to column 14 line 36; and column 15 lines 1-30).

(E) Argument: There is simply no teaching or suggestion for one of ordinary skill in the art to supplement the previously discussed deficiencies of Baranowski based on the disclosure of Baranowski. Thus, claim 19 is not rendered unpatentable by Baranowski.

Response: The test of the obviousness is:

Subject matter is unpatentable under section 103(a) if "it would have been obvious to a person having ordinary skill in the art. While there must be some teaching, reason suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior arts specifically suggest making the combination." As shown in *In re Nilssen*, 851 f. 2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988).

“Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it address.” As shown in *In re wood*, 599 f. 2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979).

Baranowski discloses that each (base station, system controller, and portable device) having storage media (memory) for storing executable programs, which are enabling a computer system to distribute information on a shopping mall to portable device of customers (figures 1-3; column 5 lines 61-67; column 6 lines 15-25; and column 7 lines 5-13). “Official Notice” is taken that the concept and advantages of dividing the program into a plurality of segments, and each divided segment is recorded on one or another of said plurality of storage media is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Baranowski by dividing the program into a plurality of segments, and each divided segment is recorded on one or another of the plurality of storage media because it would have improved memory organization and memory access control.

Accordingly, appellant’s arguments that “claim 19 is not rendered unpatentable by Baranowski” are moot.

(F) Conclusion: In conclusion, for at least the foregoing reasons, the examiner concludes that the arguments with respect to claims 3, 5-6, 9, 11-12, 15, 17-19, and 25 filed on December 12, 2007 have been fully considered but they are not deemed to be persuasive and insufficient to overcome the rejection of claims 3, 5-6, 9, 11-12, 15, 17-19, and 25 based upon the US Patent to Baranowski (U.S. Patent No. 6,813,608) reference applied under 35 USC § 102(e) and 103(a) as set forth in the final rejection and respectfully requests that the rejections should be sustained.

RELATED PROCEEDING(S) APENDIX

22. No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.
23. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Bharat N Barot/

Primary Examiner, Art Unit 2155

March 12, 2008

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